

REMARKS

Claims 1-9 and 31-34 are pending.

Claims 1-4 and 31-34 stand rejected under 35 USC §102(b) as being anticipated by Holko (US Patent No. 5,358,547).

Claims 1, 2, 4-6, 33 and 34 stand rejected under 35 USC §102(e) as being anticipated by Sambucetti et al. (US Patent No. 6,573,606).

Claims 1-2 and 7-9 stand rejected under 35 USC §103(a) as being unpatentable over Qiao et al. (US Patent No. 6,803,318).

Changes in the Claims:

Claims 1 and 7 have been amended in this application to further particularly point out and distinctly claim subject matter regarded as the invention. No new matter has been added.

Rejection under 35 USC §102(b) – claims 1-4 and 31-34

Claims 1-4 and 31-34 stand rejected under 35 USC §102(b) as being allegedly anticipated by Holko (US Patent No. 5,358,547). This rejection is respectfully traversed.

A claim must be anticipated for a proper rejection under §102(a), (b), and (e). This requirement is satisfied “only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference”; see MPEP §2131 and *Verdegaal Bros. V. Union Oil*, 814 F.2d 628, 2 USPQ2d 1051 (Fed. Cir. 1984). A rejection under §102(b) may be overcome by showing that the claims are patentably distinguishable from the prior art; see MPEP §706.02(b).

Holko describes a cobalt-phosphorous-base wear resistant coating for metallic surfaces. The office action claims that Holko discloses forming a layer on top of a substrate comprising a metal portion and refers to Col. 1, lines 32-36 for support. Applicants respectfully disagree. Col. 1, lines 32-36 only states that “the present invention relates to a Cobalt-Phosphorous-base wear resistant coating for metallic surfaces. The said wear resistant coating is disclosed in numerous embodiments hereinafter.” Holko later suggests that the “coating is useful in coating surgical saw blades, files and burrs”, and “other applications including surgical instruments and

prostheses, bearing surfaces, oil well drilling and pumping equipment.” See Col. 2, lines 24-30.

In contrast, the presently claimed invention claims “a substrate having a metal portion.” Holko is silent as a substrate having a metal portion. Holko does not teach or suggest “a substrate having a metal portion.”

The presently claimed invention is, accordingly, distinguishable over the cited reference. In the view of the foregoing, it is respectfully asserted that claims 1-4 and 31-34 are now in condition for allowance.

Rejection under 35 USC §102(e) – claims 1, 2, 4-6, 33 and 34

Claims 1, 2, 4-6, 33 and 34 stand rejected under 35 USC §102(e) as being allegedly anticipated by Sambucetti et al. (US Patent No. 6,573,606). This rejection is respectfully traversed.

A claim must be anticipated for a proper rejection under §102(a), (b), and (e). This requirement is satisfied “only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference”; see MPEP §2131 and *Verdegaal Bros. V. Union Oil*, 814 F.2d 628, 2 USPQ2d 1051 (Fed. Cir. 1984). A rejection under §102(b) may be overcome by showing that the claims are patentably distinguishable from the prior art; see MPEP §706.02(b).

Sambucetti describes a single metal alloy layer of an alloy of the A-X-Y type, where A is Co or Ni, X is W, Sn, or Si, Y is P or B.

In contrast, the presently claimed invention claims “a group VIII metal and an element comprising Carbon.” Sambucetti does not teach or suggest “a group VIII metal and an element comprising Carbon.”

The presently claimed invention is, accordingly, distinguishable over the cited reference. In the view of the foregoing, it is respectfully asserted that claims 1, 2, 4-6, 33 and 34 are now in condition for allowance.

Rejection under 35 USC §103(a) – claims 1-2 and 7-9

Claims 1-2 and 7-9 stand rejected under 35 USC §103(a) as being allegedly unpatentable over Qiao et al. (US Patent No. 6,803,318). This rejection is respectfully traversed.

Under MPEP §706.02(j), in order to establish a prima facie case of obviousness required for a §103 rejection, three basic criteria must be met: (1) there must be some suggestion or motivation either in the references or knowledge generally available to modify the reference or combine reference teachings (MPEP §2143.01), (2) a reasonable expectation of success (MPEP §2143.02), and (3) the prior art must teach or suggest all the claim limitations (MPEP §2143.03). See *In re Royka*, 490 F. 2d 981, 180 USPQ 580 (CCPA 1974).

Applicant respectfully submits that the proposed modification of Qiao does not teach or suggest all of the claim limitations of claims 1-2 and 7-9.

Qiao teaches a layer of conductive material 16 that may include multiple layers of material. There is no suggestion or motion in Qiao to have a metal capping layer comprising “a group VIII metal and an element comprising Carbon.”

Applicant therefore submits that the rejection based the Qiao reference be withdrawn. Thus, Applicant submits that claims 1-2, and 7-9 recite novel subject matter which distinguishes over any possible modification of Qiao.

Conclusion

For all of the above reasons, applicants submit that the amended claims are now in proper form, and that the amended claims all define patentable subject matter over the prior art. Therefore, Applicants submit that this application is now in condition for allowance.

Request for allowance

It is believed that this Amendment places the above-identified patent application into condition for allowance. Early favorable consideration of this Amendment is earnestly solicited.

Invitation for a Telephone Interview

If, in the opinion of the Examiner, an interview would expedite the prosecution of this application, the Examiner is invited to call the undersigned attorney at the number indicated below.


Extension of Time

Pursuant to 37 C.F.R. 1.136(a)(3), applicant(s) hereby request and authorize the U.S. Patent and Trademark Office to (1) treat any concurrent or future reply that requires a petition for extension of time as incorporating a petition for extension of time for the appropriate length of time and (2) charge all required fees, including extension of time fees and fees under 37 C.F.R. 1.16 and 1.17, to Deposit Account No. 02-2666.

Respectfully submitted,

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